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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/830,605

04/30/2001

Akira Ichikawa

Q64273

9350

7590

03/17/2004

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/830,605

**Applicant(s)**

ICHIKAWA ET AL.

**Examiner**

Victor S Chang

**Art Unit**

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 2/2/2004. Applicants' amendments to claims 1 and 4-5, cancellation of claim 3, and replacement sheet of drawings have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Claim Rejections - 35 USC § 112***

4. Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner notes that claims are still replete with vague and indefinite recitations. The Examiner respectfully suggests that further clarification is necessary. For example:

In claims 5 and 7, lines 1-2 of each claim, the phrase "a surface layer" is vague and indefinite, because it is unclear to the Examiner what is the significance of "a surface layer". In particular, the Examiner notes that since a circuit substrate of claim 1 inherently has two "surface layers", claims 5 and 7 also appear to be improperly dependent on claim 1 or 2, and claim 4, respectively, for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend

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the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

In claim 6, line 5, the phrase "said surface layer" lacks antecedent basis. Also, the phrase appears to be vague, indefinite, as set forth above. Clarification is required.

### ***Response to Amendment***

5. Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimura et al. (US 6065701) in view of Applicants' admission.

It is noted that newly amended claim 1, last line, now recites "adhesive layer is suitable for application to an article." The Examiner notes that a recitation that an element is "suitable for" performing a function is not a positive limitation but only requires the suitability to so. As such, it does not constitute a structural limitation in any patentable sense.

Tanimura's invention is directed to a label comprising electronic components (Abstract). In Fig. 2, Tanimura shows an adhesive label having an antenna wiring and an IC (electronic components) formed on a polyimide substrate, and sandwiched between two adhesive layers 15 and 17. An exfoliative paper 18 (release layer) is laminated on the outer surface of the both faces adhesive material 17 (double sided pressure sensitive adhesive layer). The adhesive layer 15 completely covers the electronic components. Additionally, Tanimura teaches a reinforcing material 14 is laminated on the opposite side of the adhesive layer 15.

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For claims 1, 2 and 4-7, Tanimura lacks a specific teaching that the electronic components may be formed on both surfaces of the polyimide substrate. However, it is noted that Applicants appear to have admitted that an adhesive label containing a contact-less data carrier element mounted on one or both surfaces of a circuit substrate, with connecting through-hole in the latter case, is conventional and well known (Specification, pages 1-2, connecting paragraph). As such, it would have been obvious to one of ordinary skill in the art to combine the teachings of Tanimura and Applicants' admitted conventional circuit substrate having a contact-less data carrier element mounted on one or both surfaces of a circuit substrate, either on one side or both sides, to form a suitable contact-less adhesive label which reads on the instantly claimed invention, motivated by the desire to form a durable integral label assembly. It should be noted that the selection of (and substituting) a known (equivalent) material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

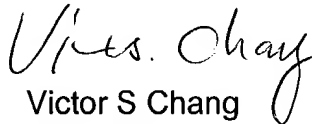
Applicants' argument "pressure sensitive adhesive layer 15 does not come into direct contact with the surface of the video cassette tape 2" (Remarks, page 6, bottom paragraph) has been carefully considered, but is not persuasive. In particular, Applicant argues the cited references individually. In response to Applicant's arguments, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

3/15/2004